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KYOCERA WIRELESS CORP. P.O. BOX 928289 SAN DIEGO, CA 92192-8289				
			EXAMINER	
			SHEDRICK, CHARLES TERRELL	
			ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/718,861

Applicant(s)

KAPLAN, DIEGO

Examiner

Charles Shedrick

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 22 December 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached arguments.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 12/22/06 have been fully considered but they are not persuasive.

Section A. of Applicant arguments of Claims 1-6 and 21

1. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, The Primary reference Shanahan teaches i.e., downloading data. For instance in paragraph 004 Shanahan notes that “*Computer 90 may also coordinate information downloading with respect to the memory capacity of device 20. For example, if the user-selected information exceeds the available memory of device 20, computer 90 may inform the user, via link 33, that the selected information is larger than the available memory*”.

As a secondary reference Kamada teaches an external storage solution in addition to storing information on a portable device by using an external storage device. Kamada teaches the external storage in a manner of improvement in addition to the internal memory of a portable device. For instance as outlined in the background of Kamada his motivation for improvement is so that applications and computer programs that are downloaded to a device such as those of Shanahan are not lost in the event that a device with limited capacity decides to download more

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programs. According to Shanahan programs and content can be uploaded and downloaded to a dedicated storage service as if it was part of the user's own portable device.

[Kamada Paragraph 0081] *"Note that a dedicated storage area in the storage server may be used by the user freely and, therefore, may be used not only as an area to store applications purchased from a sales server and its data but also as an area to store any data. That is, a dedicated storage area may be used as if it was a part of user's own portable data terminal".*

...as cited by the examiner in the previous action.

Landis teaches managing data transfer between computing devices (e.g., see at least title and abstract). Kamada and Shanahan teach transferring data between computing devices. As cited by the examiner Landis provides motivation in that *"the profile 200 is a collection of variables including characteristics of the client which can be used by the server 108 to optimize transmission costs, time, and reliability based on the client's computing and storage capabilities, client preferences, and other client response parameters"*. Therefore, based on at least the examples above motivation has been adequately provided and the rejection is proper.

2. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., **obtaining profile information from the wireless communication device**) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). A careful examination of claim 1 reveals the following recitation...*obtaining profile information for the wireless communication device.*

Section B. of Applicant arguments of Claims 7-13 and 23-28

3. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, In this case, The Primary reference Shanahan teaches i.e., downloading data. For instance in paragraph 004 Shanahan notes that *"Computer 90 may also coordinate information downloading with respect to the memory capacity of device 20. For example, if the user-selected information exceeds the available memory of device 20, computer 90 may inform the user, via link 33, that the selected information is larger than the available memory"*.

As a secondary reference Kamada teaches an external storage solution in addition to storing information on a portable device by using an external storage device. Kamada teaches the external storage in a manner of improvement in addition to the internal memory of a portable device. For instance as outlined in the background of Kamada his motivation for improvement is so that applications and computer programs that are downloaded to a device such as those of Shanahan are not lost in the event that a device with limited capacity decides to download more programs. According to Shanahan programs and content can be uploaded and downloaded to a dedicated storage service as if it was part of the user's own portable device.

[Kamada Paragraph 0081] *"Note that a dedicated storage area in the storage server may be used by the user freely and, therefore, may be used not only as an area to store applications*

purchased from a sales server and its data but also as an area to store any data. That is, a dedicated storage area may be used as if it was a part of user's own portable data terminal".

...as cited by the examiner in the previous action.

4. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

5. Applicant further argues with respect to the third prong of an obviousness analysis, the combination of the references does not yield all the limitations of independent claims 7, 23, and 24. Specifically, claim 7 requires that the utility programs are executed on the wireless connectivity toolkit server and that the wireless communication device is allowed access to upload and download files to and from a portion of the data storage area on the wireless connectivity toolkit server that is reserved for the wireless communication device. Neither Shanahan nor Kamada teach these limitations. Importantly, in Kamada, the server apparatus remains in control of the server based storage. Kamada teaches that the server routes files obtained by a user of the handset to a server based storage area. The handset in Kamada is not allowed upload access to this storage area. Kamada teaches that only the server accesses the storage area, which is used to temporarily house files until they expire. **This does not teach the claimed invention.**

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6. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

As disclosed in the previous rejection Shanahan discloses A wireless connectivity toolkit system, comprising: a wireless connectivity toolkit server having a data storage area and a plurality of utility programs (i.e., see at least figure 1 and paragraphs 0021-0025), the toolkit server communicatively coupled with a wireless communication network(i.e., see at least figure 1 and paragraphs 0021-0025); a wireless communication device communicatively coupled with the wireless connectivity toolkit server via the wireless communication network (i.e., see at least figure 1 and paragraphs 0021-0025), wherein the wireless communication device establishes a session with the wireless connectivity toolkit server over the wireless communication network(i.e., see also paragraphs 0025, 0030,0038,0039,0042,0046,0061), the session allowing execution of the utility programs on the wireless connectivity server and allowing access to a portion of the data storage area for the wireless device for loading files(i.e., see also paragraphs 0025, 0030,0038,0039,0042,0046,0061).

However, Shanahan does not specifically teach a reserved data storage area for the wireless communication device for uploading and downloading of files. In analogous art, Kamada teaches a reserved data storage area for the wireless communication device for uploading and downloading of files (i.e., see at least paragraph 0081).

Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Shanahan to include a reserved data storage area for the wireless

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communication device for uploading and downloading of files for the purpose of improving upon the limited storage capacity as taught by Kamada in paragraph 0001.

From Shanahan we can see from at least paragraph 0024 that the teaches of various "utilities" for downloading are covered by the broad teaching cited in the specification paragraph 0024 where Shanahan discloses that source 50 may be any device or combination of devices suitable for providing user-defined information to programmer 30 (e.g., the Internet, an optical disc player (CD, DVD), a cassette player, a VCR, a digital camera, or *any suitable storage device containing computer programs or files, etc.*). Kamada further teaches downloading software and software applications. The examiner respectfully notes that the language of the claim does not provide an inventive step or feature that distinguishes the claimed invention over the prior art or combination thereof. The claim language submitted by the Applicant does not distinguish over the prior art in manner that one of ordinary skill in the art would not obviously understand how to download software, computer program (i.e., binary code, 1's and 0's) from one device to another and store via internal or external memory. Furthermore, as a future reference the examiner respectfully notes that File Transfer (e.g., using FTP, TFTP programs) are notoriously well-known in the art (e.g., see FTP or TFTP protocol etc.) and therefore, the claims as written are not in condition for allowance at this point.

Section C. of Applicant arguments of Claim 22

7. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge

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generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, simplicity as noted in detail by the cited paragraph and summarized by at least the first sentence of the abstract.

8. Applicant further argues that the claimed limitations are not met. However, the Examiner respectfully disagree. Based on a careful examination of the claims and the Applicants specification. The claim language has been written in a manner that gives way to a very broad interpretation. For instance;

Claim 22 reads (previously presented) The method of **claim 1, wherein the providing step** further comprises compressing (e.g., providing a method to reduce or collapsed the provided sub menus of a given hierarchy) the menu of available connectivity toolkit utilities, wherein the menu is uncompressed (expanded to sub menus) by the wireless communication device prior to being displayed (the menus are compressed and uncompressed based on a user action and what the user would like to see that he hasn't already seen based on the layout of the currently displayed menu).

The providing step of clam 1 reads → *providing a menu of available connectivity toolkit utilities, wherein the menu is displayed on the wireless communication device* (e.g., providing visually, wirelessly and any other means of providing not limited by the language of this claim as presently presented).

Based on the broadest reasonable interpretation of the claim the cited prior art does in fact read upon the claimed limitation and therefore the rejection is proper and maintained. The Examiner respectfully notes that the claims as written are not written in a manner that overcome the prior

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art and therefore the rejection is proper and the claims are not in condition for allowability at this time.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Shedrick whose telephone number is (571)-272-8621.

The examiner can normally be reached on Monday thru Friday 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kincaid Lester can be reached on (571)-272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Charles Shedrick
AU 2617
February 1, 2007


LESTER G. KINCAID
SUPERVISORY PRIMARY EXAMINER